

### REMARKS

Claims 21-40 are pending in this application. Claims 1 through 20 have been cancelled and claims 21-40 have been added. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

#### Specification Objections

The abstract was objected to for including misspelled word "another". Applicants have amended line 4 of the abstract to remove "anther" and replaced it with "another". The specification was also objected for lacking generic terminology for trademark terms "MAMMOTOME" and "GEL MARK". Applicants have amended the specification to provide a generic term for "MAMMOTOME", namely biopsy or tissue removal device. However, Applicants note "GEL MARK is already described generically as a Gelfoam pellet. See p. 2, line 10. In view of the foregoing, Applicants believe that these objections are traversed and/or rendered moot.

#### Claim Objections

Claims 5 and 15 have been objected to for using the terms "about" and/or "substantially". The Examiner asserts that while these claims would be understood by one skilled in the art, they should be removed to improve clarity and precision of the claims. Applicants respectfully disagree that this is necessary.

Applicants note that some of the newly added claims include both terms "about" and "substantially" in the same context as the Examiner objects to. Applicants note that the MPEP § 2173.05(b) teaches that "the fact that claim language, includ[es] terms of degree, [that] may not be precise, does not automatically render the claim indefinite...". Instead, the test is "whether one of ordinary skill in the art would understand what is claimed, in light of the specification." Id. Since the Examiner has already acknowledged that "one skilled in the art would understand what is being

claimed in light of the specification". Applicants do not believe any change is required in the present claims.<sup>1</sup> Accordingly, Applicants have traversed these objection.

#### Claim Rejections

Claims 1-20 have been rejected under 35 U.S.C. §102 or §103 based upon U.S. Patent Nos. 5,853,366, 6,220,248, 6,234,177, 6,371,904, 6,549,800, WO 00/24320 and/or WO 00/67833. Without acquiescing to these formulated rejections, claims 1 through 20 have been cancelled rendering these rejections moot. Applicants have added new claims 21-40, which appear to overcome the prior art of record.

#### New Claims

As discussed with Examiner Melanie Tyson on July 24, 2006, during a brief telephone conversation, Applicants have added new claims 21-40 to seek patent protection based upon claims already determined to be patentable (e.g. has been found novel, include an inventive step and has industrial application) by the PCT International Preliminary Examining Authority. A copy of the search report used by the PCT Authority was presented to the Examiner on September 9, 2004 and subsequently considered on June 15, 2006. Also, a copy of the corrected Notification of Transmittal of the International Preliminary Examination Report was faxed to Examiner Tyson on July 24, 2006. The Authority's patentability determination was in view of all but one<sup>2</sup> of the references used by the Examiner in formulating the current rejections. These claims substantially correspond to PCT Claims as demonstrated in the following chart.

Pending Claims	Corresponding PCT Claims	PCT Determination
Claim 21	Claim 1	Novel, Inventive Step and Industrial Application.
Claim 22	Claim 2	Novel, Inventive Step and Industrial Application.
Claim 23	Claim 3	Novel, Inventive Step and Industrial Application.
Claim 24	Claim 4	Novel, Inventive Step and

<sup>1</sup> See Present Office Action dated June 29, 2006, p. 2.

<sup>2</sup> The Examiner also rejected previously submitted claims 17 through 20 under 35 U.S.C. §103(a), in part, based upon U.S. Patent No. 6,549,800, to Atalar et al.

Claim 25	Claim 5	Industrial Application.
Claim 26	Claim 6	Novel, Inventive Step and Industrial Application.
Claim 27	Claim 7	Novel, Inventive Step and Industrial Application.
Claim 28	Claim 8	Novel, Inventive Step and Industrial Application.
Claim 29	Claim 9	Novel, Inventive Step and Industrial Application.
Claim 30	Claim 10	Novel, Inventive Step and Industrial Application.
Claim 31	Claim 33	Novel, Inventive Step and Industrial Application.
Claim 32	Claim 13	Novel, Inventive Step and Industrial Application.
Claim 33	Claim 14	Novel, Inventive Step and Industrial Application.
Claim 34	Claim 16	Novel, Inventive Step and Industrial Application.
Claim 35	Claim 17	Novel, Inventive Step and Industrial Application.
Claim 36	Claim 26	Novel, Inventive Step and Industrial Application.
Claim 37	Claim 27	Not examined due to Subject Matter.
Claim 38	Claim 28	Not examined due to Subject Matter.
Claim 39	Claim 29	Not examined due to Subject Matter.
Claim 40	Claim 30	Not examined due to Subject Matter.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants reserve the right to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.


Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

### **CONCLUSIONS**

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicants have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge Deposit Account No. 50-1097 for any fee which may be due.

Date:



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